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09/682,594	09/25/2001	Bruce Preston Williams	201-0238 GMB	5196

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EXAMINER

NEWHOUSE, NATHAN JEFFREY

ART UNIT PAPER NUMBER

3727

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 61304

Application Number: 09/682,594
Filing Date: September 25, 2001
Appellant(s): WILLIAMS

Larry W. Miller
For Appellant

MAILED
JUN 16 2004
GROUP 3700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed April 13, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 35 and 37-39 stand or fall together as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,338,427	AFTANAS et al.	1-2002
GB 1043227	PARKINS	9-1966

(10) *Grounds of Rejection*

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The following ground(s) of rejection are applicable to the appealed claims:

Claims 35, 37-39 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office Action, Paper No. 13, paragraph #5.

Claims 35 and 37 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 13, paragraph #7.

Claims 35 and 37-39 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 13, paragraph #9.

(11) Response to Argument

1. New Matter Rejection under 35 USC 112, first paragraph.

Appellant argues that there is support for the added subject matter, either in the drawings or in the specification and/or drawings of the provisional application (60/259,005). Appellant further argues that any subject matter added was to cure defects, obvious to one skilled in the art or in response to queries made by the examiner or to clarify the invention originally disclosed.

In response, the history of the prosecution of this application bears consideration. Initially, in the first office action, the claims, specification and drawings were rejected under 35 USC 112, first paragraph, as failing to provide an adequate written description to make and/or use appellant's invention. In response to this rejection, appellant did not argue that there was an adequate written description, but amended the specification, drawings and claims to more clearly describe appellant's invention. These amendments resulted in the rejection under 35 USC 112, first paragraph as containing new matter.

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As set forth previous, appellant filed an application with a broad written disclosure. When the examiner stated that there was insufficient description to make and/or use appellant's invention, appellant attempted to rely on the subject matter set forth in the provisional application. The provisional application did not set forth the subject matter of appellant's invention in any more detail than the originally filed instant application. Now appellant is attempting to argue that these changes made were simply to clarify appellant's invention and one of ordinary skill would know how appellant's invention would work based on the originally filed specification(see declaration of Le Nguyen) or are a result of the examiner's queries. First, as pointed out in the advisory, the declaration of Le Nguyen is inadequate support for appellant's argument that one of ordinary skill in the art would know how appellant's invention would function. Mr. Le Nguyen appears to be an expert in the area of automotive industry with more than 25 years of experience. As there is no showing that one of ordinary skill in the automotive industry is one having 25 years of experience, therefore, the assertions of Mr. Nguyen are not to be consider by one of "ordinary skill" in the art. In addition, the examiner has set forth examples of how the roof rack originally disclosed might function differently.

There are numerous discrepancies between the roof rack in the first position, coincident with the roof of the vehicle(figure 1) and the roof rack in the second position, coincident with the side of the vehicle(figure 2). Certain portions of the roof rack disappear between these two positions, the portion forward of #50 on the right side of figure 1, the connection between adjacent portions of rail (26) along each side of the

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vehicle (above portion #50 on the left side of figure 1). In addition, there is no support in the originally filed disclosure, or provisional application, for the rails or track elements that allows for the storage surface to move from atop the vehicle to the side of the vehicle. There are numerous other ways to achieve this movement than what was added in by amendment. The hinge bars which allow the collapsible rails to fold into the storage position were not originally set forth.

In conclusion, it would appear that appellant filed a specification, drawings, etc. that did not adequately describe appellant's invention. To add the subject matter by amendment is only permissible if there is some support in the originally filed application. Clearly, there is no support for the added limitations directed to how the roof rack functions in the instant application.

2. Anticipation Rejection Under 35 USC 102(e).

Appellant argues that Aftanas does not teach the roof rack in a second position along "a lateral side of the vehicle". This argument was first presented in the amendment after final filed February 17, 2004. First, it is to be noted that only claims 35 and 37 are rejected under 35 USC 102(e) as being anticipate by Aftanas. In response, it should first be noted that appellant is only claiming a roof rack and the recitation of the vehicle and its relation to the roof rack is merely functional language. Aftanas teaches that the roof rack has a first position that is coincident with the roof of a vehicle (figure 18) and a second position behind the vehicle (figure 19). The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by

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Aftanas which is capable of being used in the intended manner, i.e., with a second position that is along the side of the vehicle instead of behind the vehicle. (see M.P.E.P. 2111). With respect to claim 37, the recesses (212) that are capable of receiving a bungee cord.

3. Obviousness Rejection Under 35 USC 103(a).


Appellant argues that the combination of Aftanas in view of the Great Britain reference 1,023,227(Parkins) does not teach the roof rack in a second position along “a lateral side of the vehicle”. This argument was first presented in the amendment after final filed February 17, 2004. In response, it should first be noted that appellant is only claiming a roof rack and the recitation of the vehicle and its relation to the roof rack is merely functional language. Aftanas teaches that the roof rack has a first position that is coincident with the roof of a vehicle (figure 18) and a second position behind the vehicle (figure19). The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Aftanas which is capable of being used in the intended manner, i.e., with a second position that is along the side of the vehicle instead of behind the vehicle. (see M.P.E.P. 2111).

Parkins was applied to show that collapsible rails hingedly attached to roof racks are well known in the art. These types of rails allow for flat storage when not in use so the roof rack is generally flat against the roof of a vehicle and can be folded upwardly to provide sides to the roof rack to hold items placed on the roof rack more securely and increase the amount of items that can be placed on the roof rack.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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June 14, 2004

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